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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,754	08/24/2001	Samuel J. Danishefsky	2003080-0083 (SK-943-US)	4106
24280	7590	10/17/2005	EXAMINER	
CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110			COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,754

Applicant(s)

DANISHEFSKY ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7-22, 24-28, 30, 33-35, 38, 57, 58 and 63-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 7-22, 24-28, 57, 58 and 67-70 is/are allowed.
- 6) ☒ Claim(s) 2, 3, 30, 33-35 and 38 is/are rejected.
- 7) ☒ Claim(s) 63-66, 71 and 72 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Claims 1-3, 7-22, 24-28, 30, 33-35, 38, 57, 58 and 63-72 are pending in the application.

This action is in response to applicants' amendment filed July 22, 2005. Claims 1-3, 8, 11, 15-17, 30, 33 and 38 have been amended and claims 73 and 74 have been canceled.

### *Response to Amendment*

Applicant's amendments filed July 22, 2005 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection of claims 30, 33-35, 38, 59, 61-66 and 71-74 labeled paragraph 1 maintained in the last office action, which is hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejection of claims 73 and 74 labeled paragraph 3 maintained in the last office action, which is hereby **withdrawn**.
3. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 13, 14, 21, 30, 33, 38, 73 and 74, labeled paragraph 4 in the last office action, which is hereby **withdrawn**.
4. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 13, 14, 21, 30, 33, 38, 73 and 74, labeled paragraph 5 in the last office action, which is hereby **withdrawn**.

5. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 9, 13, 19, 21, 30, 33, 38, 73 and 74, labeled paragraph 6 in the last office action, which is hereby **withdrawn**.

6. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 13, 14, 21, 30, 33, 38, 73 and 74, labeled paragraph 7 in the last office action, which is hereby **withdrawn**.

7. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 10, 13, 19-21, 30 and 73, labeled paragraph 8 in the last office action, which is hereby **withdrawn**.

8. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 13, 19, 21, 30 and 73, labeled paragraph 9 in the last office action, which is hereby **withdrawn**.

9. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19-21, 30 and 73, labeled paragraph 10 in the last office action, which is hereby **withdrawn**.

10. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19-21, 30 and 73, labeled paragraph 11 in the last office action, which is hereby **withdrawn**.

11. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19-21, 30 and 73, labeled paragraph 12 in the last office action, which is hereby **withdrawn**.

12. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19-21, 30 and 73, labeled paragraph 13 in the last office action, which is hereby **withdrawn**.

13. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19-21, 30 and 73, labeled paragraph 14 in the last office action, which is hereby **withdrawn**.

14. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19-21, 30 and 73, labeled paragraph 15 in the last office action, which is hereby **withdrawn**.

15. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19-21, 30 and 73, labeled paragraph 16 in the last office action, which is hereby **withdrawn**.

16. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19-21, 30 and 73, labeled paragraph 17 in the last office action, which is hereby **withdrawn**.

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17. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102(b) rejection of claims 1, 7, 9, 12, 19, 20, 30 and 73, labeled paragraph 18 in the last office action, which is hereby **withdrawn**.

In view of the amendment dated July 22, 2005, the following new grounds of rejections apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claims 2, 3, 30, 33-35 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The previously dependent claim 2 was amended to an independent claim where none of the provisos were included in the amendment of claim 2, which includes compounds previously excluded by the provisos and thus are not defined in the specification with respect to the genus.

Applicant is required to cancel the new matter in the reply to this Office action.

***Claim Objections***

19. Claims 65, 66 and 72 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot be dependent on another multiple dependent claim.

20. Claims 63, 64 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Allowable Subject Matter***

21. Claims 1, 7-22, 24-28, 57, 58 and 67-70 are allowed. None of the prior art or record or a search in the pertinent art area teaches the compounds of the instant invention.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brenda L. Coleman  
Primary Examiner Art Unit 1624  
October 13, 2005